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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUBERT HAUSER,
HERBERT STADELMANN,
ANDREAS KASPER

Appeal 2009-1284
Application 10/518,534
Technology Center 1700

Oral Hearing Held: Thursday, March 19, 2009

Before TERRY J. OWENS, MARK NAGUMO, and
JEFFREY B. ROBERTSON, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

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1 The above-entitled matter came on for hearing on Thursday,
2 March 19, 2009, commencing at approximately 2:43 p.m., at the U.S. Patent
3 and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before
4 Kevin E. Carr, Notary Public.

5 MR. BULLARD: May I proceed, Your Honors?

6 JUDGE NAGUMO: Yes.

7 MR. BULLARD: My name is Christopher Bullard and I
8 represent the Appellant in Appeal Number 2009-1284.

9 In this case, there are two independent claims, independent
10 Claims 18 and 35, that are separately argued on appeal. Each of these claims
11 requires three distinct elements, one of which is not disclosed or suggested
12 in the cited reference. In particular, each of these claims recites a smooth
13 glass pane, a marking field that has an uneven surface, and a marking layer.

14 The first two pages of disclosure in this application are, in fact,
15 a discussion of the reference that the Examiner cited. In particular, the
16 reference of the international application, of which the Dauba reference is
17 the national stage application, is discussed in the first two pages of
18 Applicant's disclosure. Applicant -- the Appellant noted that with the Dauba
19 method of marking, after tempering, but before aging at a predetermined
20 point on a pane, a marking can be applied or alternatively on a thin film that
21 covers the pane.

22 So the Appellants recognize that Dauba teaches that you can
23 have a glass pane or a thin film that covers that pane and a marking layer is
24 applied. The improvement that the Appellants have recognized that goes
25 beyond Dauba is the production of a marking field. That marking field is

1 recited in each of Claims 18 and 34 and is not disclosed or suggested by
2 Dauba.

3 JUDGE OWENS: The Examiner found that Dauba's glaze is a
4 marking field and that it inherently is less smooth than glass. Where in your
5 briefs do you say the Examiner is wrong?

6 MR. BULLARD: Well, there's two points I would like to
7 respond to, Your Honor. There are two areas where the Examiner has erred
8 in the interpretation of the glazing. I will point to specifically where we
9 addressed that in the appeal briefs to directly answer your question.

10 At page 5 -- the paragraph that begins towards the bottom of
11 page 5 -- the Applicant notes that Dauba specifically defines the term
12 glazing. So the first point that I would like to make to the Board and bring to
13 the Board's attention is that the Examiner's interpretation of glazing is of the
14 Examiner's own invention that is distinct from what Dauba specifically
15 states a glazing to be.

16 JUDGE OWENS: But where does this argument in your brief
17 say the Examiner is wrong? The Examiner says the surface of the glaze --
18 let me see.

19 MR. BULLARD: The Applicants further submit that
20 Examiner's interpretation that the glaze on the glass pane is equivalent to the
21 marking field of the present invention is incorrect, particularly insofar as
22 Dauba specifically defines the term glazing as "encompassing single or
23 multiple glass panes, such as being bare or coated with thin films such as
24 pyrolytic films with thick films such as enamels.

25 JUDGE OWENS: Isn't the Examiner arguing that the films are
26 what is coarser or less smooth than the glass?

1 MR. BULLARD: Well, the Examiner does make an argument
2 along those lines, and I think what Your Honor is saying is that the
3 Examiner -- although the Examiner characterizes the term "glazing," which
4 is used through Dauba, as something that's different than what Dauba
5 describes it to be. In Dauba, they say that it can be the layers of glass
6 themselves or these layers include -- may have a layer on it.

7 But the point Your Honor is making is, even if we step back
8 from that interpretation -- that erroneous interpretation and say, well, fine,
9 there's glass panes and then we have a film that's on top of those glass
10 panes. The Examiner tries to have it both ways. In the Examiner's rejection
11 and also in the Examiner's Answer, the Examiner states that it's inherent
12 that the glass panes are smooth, but then says that the glazing -- which as
13 I've noted in Dauba, is the glass panes in the films on the plane is inherently
14 rough.

15 So the Examiner doesn't provide support for this inherency
16 argument. The Examiner is stating that by way of the adhesion to Dauba,
17 that is described in Dauba, there must be some marking field in there. There
18 must be some roughness. That's an alternative argument that the Examiner
19 makes.

20 But the -- as I noted, the Examiner's interpretation is wrong
21 because the glazing is not a glazing that is a coating on something. The
22 glazing is, as the Applicants recognized in the first two pages of the
23 disclosure, it's glass panes or thin film covering the latter. As Applicants
24 noted on page 2 of their disclosure as originally filed, they noted the
25 problems with this type of marking. It does not include the intermediate
26 production of a marking field. At page 2, columns 15 to 27, and as noted in

1 the reply brief, the Applicant notes that the surface in Dauba allows for the
2 marking layer to be removed in a manner that's disadvantageous. In
3 particular, in this field, the marking is used to identify whether the tempered
4 glass has undergone a treatment which indicates the glass is now safe.

5 JUDGE OWENS: But is it the Examiner's position that the
6 coated glass in Dauba is the marking field?

7 MR. BULLARD: I think that that is the Examiner's position,
8 that a coated glass is a marking field. I think that the Examiner's position
9 suffers from a bit of the Examiner's own creation when it says that Dauba
10 teaches use of a glazing which may be fixed to the glass to receive the
11 markings. The glaze, which inherently possesses a rougher, more graineous
12 surface than the glass, the glazing is the glass. The mere recitation of a
13 description of a glazing doesn't mean that it includes a rougher surface.

14 In fact, Dauba -- Dauba itself notes that column 2, lines 52 to
15 59, that the substance may be fixed either on the glass or on the film. Dauba
16 makes no distinction as to the type of surface that the thin film has, and
17 there's no support on the record that that thin film is inherently more rough
18 than the glass.

19 JUDGE OWENS: Where do you say that in your brief that it is
20 not inherently rougher, that there is no support for being inherently rougher?

21 MR. BULLARD: Your Honor is correct. We do not directly
22 address the inherency allegations that are made by the Examiner in our brief
23 or the reply brief, but I think it would be remiss, and I would not fully be
24 able to fully respond to your question if I didn't address that issue before
25 you today, Your Honor.

1 So I agree that it's not a point that was specifically raised in the
2 brief, but it is a point that's important because it is a point that tails onto the
3 Examiner's incorrect interpretation of glazing.

4 So with this point and with the points that were made in both
5 the appeal and reply brief, the Applicants respectfully request that the
6 rejections based on Dauba be reversed.

7 JUDGE OWENS: The Examiner said that he had previously
8 challenged the Appellants to provide a convincing showing that the
9 markings cannot be removed by acid etching, a steel blade or chipping by a
10 chisel or grinding. Where does your brief say that that is wrong?

11 MR. BULLARD: In our appeal brief -- and what Your Honor
12 is referring to and what the Examiner was initially referring to was a
13 statement that was made in the Advisory Action that was mailed on October
14 26, 2007. The question that this is directly related to is the limitation of the
15 permanently bonded that is recited in independent Claim 18. On page 3 of
16 the appeal brief -- the amended appeal brief -- it states, "As discussed on
17 page 5, line 29 through page 14, line 17, the object of the invention is to
18 provide a method of visual marking of the substrates undergoing a heat
19 treatment, which ensures that the marking color cannot be mechanically
20 removed from the surface of the substrate in such a way that the substrate is
21 permanently marked."

22 What this -- and later on it states that, "As discussed at page 6,
23 lines 11 to 19 of the specification, because the intimate bonding between the
24 marking layer and the structured surface of the marking field in accordance
25 with the present invention, it's consequently no longer possible to
26 completely remove the color with the glass plane, a blade, or other tools.

1 Even by rubbing strongly with glass wool, residues of color could still be
2 identified using a microscope.”

3 In this case, the Examiner appears to be challenging whether
4 that is true. This is not the rejection that the Examiner -- that we are faced
5 with today, Your Honor. That would be a rejection under 112 or 101, where
6 the Examiner is stating along the lines of -- that goes counter to *In re Langer*,
7 where the office is to presume that a statement of utility in the application is
8 true.

9 JUDGE OWENS: The Examiner’s point is that you’re arguing
10 that your marking is permanently bonded, and the ink is -- the marking
11 material is irreversibly modified, and that in the *Dauba* reference the
12 material is only permanent sufficiently for normal handling and storage
13 conditions. You seem to be drawing a distinction, and the Examiner says
14 that you haven’t defined -- or indicates that you haven’t defined permanently
15 and irreversibly in a way that indicates that *Dauba* fails that, but yours
16 necessarily has that property.

17 MR. BULLARD: I think with regards to permanently bonded
18 limitation, Your Honor is correct in assessing what the Examiner’s position
19 and I think the briefs lay out -- both the appeal and reply brief lay out how
20 that is disclosed in the specification. But I think the more important issue
21 here, Your Honor, is that the Applicant, as described in the second page of
22 the disclosure recognized that the method described in *Dauba* leaves
23 something wanting in that it can be removed under a specific set of
24 circumstances, this removal with a glass plane, or it can be completely
25 removed, which is outside of what is disclosed during normal handling
26 operations.

1 But the most important thing I want to bring to the Board's
2 attention is that these are both method claims, and these method claims
3 specifically recite the creation of the marking field, and the permanent
4 bonding that is a result of the creation of that marking field is, I believe,
5 confusing the issue in terms of how Dauba -- what the limits are of what
6 Dauba recites. The most important thing to remember is, as I've noted, we
7 recite a smooth glass pane -- a marking field with an uneven surface, and
8 then a marking layer, whereas Dauba only recites a smooth glass pane or a
9 thin film. As I've noted, Your Honor, Dauba says that that marking layer
10 can be applied to either the pane or the thin film and then that the marking
11 layer is applied there.

12 So, Your Honors, the point here is if Dauba makes no
13 distinction between the type of adhesion that occurs when it says it can be
14 applied to either the pane directly or the thin film, and if Dauba further states
15 that this is only indelible during normal handling operations, and we recite
16 something in addition to what Dauba discloses, the creation of a marking
17 field, and we describe how that enables, even though you apply rough
18 scraping that the marking can still be seen through a microscope, that's the
19 distinction we want to bring to the Board's attention today.

20 JUDGE NAGUMO: Can you direct our attention to some
21 definition of unevenness in the specification?

22 MR. BULLARD: There are many examples of the type of
23 unevenness that support the recitation in the claims. Are you specifically
24 looking for quantification, or would you like examples of how that marking
25 field is created?

1 JUDGE NAGUMO: Well, I'm looking to see what the scope
2 of uneven is as used in the claims.

3 MR. BULLARD: The scope of uneven requires some
4 additional alteration to the surface of the glass pane. That alteration can be
5 either in the form of abrading, or chemical etching, or in another
6 embodiment it can be in the form of creating another layer that is baked on
7 and creates a marking field. So there are a number of ways that the
8 Applicant discloses that an uneven surface can be created on the otherwise
9 smooth glass plane.

10 JUDGE OWENS: The Examiner says that Dauba's glass pane
11 is the glass pane, the film is the marking field, the ink goes on the marking
12 field, and since it's indelible under normal handling and storage conditions,
13 it's permanently bonded and the ink is irreversibly modified. Where in your
14 briefs do you say any of that is wrong?

15 MR. BULLARD: Well, the Examiner again has pointed to
16 other than normal handling and storage and the Examiner -- I would
17 respectfully disagree with the interpretation that Your Honor has given the
18 Examiner credit for. I believe that the Examiner has made an incorrect
19 interpretation of Dauba in that the glazing is the glass panes themselves or
20 the thin film on the panes. As I mentioned, Dauba says that the marking
21 layer can be placed either directly on the glass panes or on the film itself.

22 It makes no distinction between the type of bonding that
23 happens and whether it's on the pane or on the glaze itself. The key here is
24 that we recite a separate marking field, and throughout the brief, as I noted
25 earlier, there's a portion that attacks the Examiner's interpretation of
26 glazing. It also distinguishes the limited disclosure in Dauba of during

1 normal handling operations as being under limited circumstances, whereas
2 we recite permanently bonded.

3 But I would again draw the Board's attention to the additional
4 step that's not disclosed or suggested in Dauba, and as noted on the very first
5 page of our disclosure, we recognize that Dauba describes that the marking
6 layer can be applied either to the pane or to a thin film, but on the second
7 page the Applicant shows -- describes that Dauba can nevertheless, the
8 marking layer can be removed. This is specifically laid out in our, I believe
9 it's our reply brief. That's correct. As discussed --

10 I can't draw to the specific portion right now, Your Honor. I
11 apologize for the time.

12 JUDGE OWENS: Your spec indicates that your marking field
13 can be formed by depositing a coating?

14 MR. BULLARD: That's correct, Your Honor.

15 JUDGE OWENS: Isn't that comparable to Dauba's pyrolytic
16 films, films such as enamels? Couldn't it be comparable to that?

17 MR. BULLARD: Well, again, Your Honor, the recitation in
18 the claims refers to a marking field that is an uneven surface structure. And
19 again, although you've noted it's a question of inherency that is -- the
20 Examiner has not shown. I want to respond to your question that the
21 pyrolytic films would be any more even than the surface of the glass itself.
22 The Examiner tries to, as I note, have it both ways, say that the glass is
23 inherently smooth, but then the glazing, which is the glass, is inherently
24 rough.

25 JUDGE OWENS: The problem is he did find that and you
26 didn't challenge it in your briefs.

1 Any more questions? No more questions.

2 MR. BULLARD: Thank you, Your Honors. You have a good
3 day.

4 Whereupon, at approximately 3:03 p.m., the hearing was
5 concluded.

6